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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,816	12/16/2003	Jun Fujimoto	402914/SOEI	2882
23548 7590 03/09/2007 LEYDIG VOIT & MAYER, LTD 700 THIRTEENTH ST. NW SUITE 300 WASHINGTON, DC 20005-3960			EXAMINER PLUCINSKI, JAMISUE A	
			ART UNIT 3629	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/09/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/735,816

Applicant(s)

FUJIMOTO, JUN

Examiner

Jamisue A. Plucinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :20040330, 20050428, 20050711, 20060425, 20061004.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. With respect to Claim 1: the acronyms “IC” and “ID” are indefinite. It is unclear to the examiner what they acronyms mean. Each acronym used, must be proceeded by (accompanied by) its full term wherever it appears first in each independent claim.

4. With respect to Claim 1: the phrase “the tag ID and the detector being transmitted” is indefinite. It is unclear to the examiner, from where and to where the IDs are being transmitted. Are they transmitted separately or together?

5. With respect to Claim 1: the phrase “at a time at which the detector has detected” is indefinite. It is unclear as to what the detector has detected.

6. With respect to Claim 1: the phrase “positional information management means including the recording means, for managing” is indefinite. It is unclear to the examiner if the applicant is claiming that both the positional information management means and the recording means, together manage the positional information, or if the positional information management means contains or is in communication with the recording means.

7. With respect to Claims 7 and 9: the applicant states in the pre-amble of the claims that the invention is directed to a system. However, in the body of the claim language, the claims are

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positively reciting method steps of inputting data into the terminal and the positional information management means searches for the article based on the inputted information. Previously in previous claims, the applicant has recited method-like limitations, but have written them in a descriptive way, of how the system limitations are intended to work, or tasks they are intended to perform. Claims 7 and 9 are positively claiming steps that are performed, therefore causing it to be unclear if this is a system claim or a method claim.

8. With respect to Claim 10: the phrase "wherein a user related to the article comprises a customer of the hotel and a staff member of the hotel" is indefinite. It is unclear to the examiner how one can be both a customer and a staff at the same time, for examination purposes, the examiner is considering this to be an "or" statement, where the user can either be a customer or a staff member.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7 and 9 rejected under 35 U.S.C. 101 because they are directed to improper hybrid claims. 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a system (ex. preamble of claims 7 and 9) while the body of the claim

positively recites the use of method claims of a user positively inputting information and the management means performing a searching function in response.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, and 4-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Shore (6,225,906).

12. With respect to Claim 1: Shore discloses the use of a positional information management system comprising:

- a. A tag attached to an article and having a tag IC for storing a tag ID (Reference numeral 18 with corresponding detailed description);
- b. A plurality of detectors each having a detector ID (Reference numeral 16 with corresponding detailed description) for detecting the tag ID via transmittance from the tag IC, the tag ID and the detector ID being transmitted (Column 6, lines 9-44);
- c. Recording means for recording the tag ID, the detector ID and a time of detection (Reference numeral 42 with corresponding detailed description); and
- d. Positional information management means (central monitoring system 16 with corresponding detailed description) containing the recording means, and for managing

positional information of the article, base on the IDs and the time (See Figure 5A, for timestamp).

e. Shore discloses the use of the system being used in a hospital, not a hotel.

However it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987) and *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994)

13. With respect to Claim 2: Shore discloses the positional information management means records a relationship between the article and the tag ID and specifies the article based on the tag ID (Column 5, lines 35-48, Column 7, lines 42-61 and Column 8, lines 24-38).

14. With respect to Claim 4: Shore discloses the positional information management means specifies a position and time of the article based on the detector ID, so as to obtain a movement history of the article (See Figure 5A, The system records a timestamp on when the tag was detected, and therefore considered to be a movement history).

15. With respect to Claim 5: Shore discloses the detectors each have specific ranges in which each of the detectors detects the tag ID and the positional management system detects a movement state of the article, based on the specific ranges and the tag ID detected in the specific ranges (Column 5, lines 35-48).

16. With respect to Claim 6: Shore discloses the positional information management means specifies the detector ID based on the tag ID of the article to specify a position of the article based on the detector ID (Column 5, lines 34-48).

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17. With respect to Claim 7: Shore discloses the use of a terminal connected with the positional information management means for collecting Tag ID and transmit the positional information of the article to the terminal (Figures 5A, 6 and 8 disclose a user interface which is displayed on terminal 24).

18. With respect to Claim 8: The recording means records a relationship between a name of a user related to the article and the tag ID of the tag, and the positional information management means specifies the tag ID of the article based on the name of the user (See Figures 5A, 6 and 8 with corresponding detailed description).

19. With respect to Claim 9: Shore discloses a terminal connected with the positional information management means for collecting a name of the user and transmit the position information of the article to the terminal based on the name of the user (Figures 5A, 6 and 8 disclose a user interface which is displayed on terminal 24).

20. With respect to Claim 10: Shore discloses the user is a patient of a hospital, which the examiner considers to be a customer of the hospital. As stated above, the system being in a hotel is considered to be intended use of the system and is not patentably distinct from the system with the same structural components. Shore discloses the positional information management system further comprises service management means such as when a patient is being transported for X-ray and the status if the transport (See Figure 3) which the examiner considers to be managing the service.

21. With respect to Claim 11: Shore discloses the positional information management means determines an area defined by at least one of the detector ID and determines whether or not the

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article is in the area based on the detector ID (Column 2, lines 3-17 and 36-44 and Column 5, lines 34-48).

22. With respect to Claim 12: Shore discloses the positional information management system defines the area as a restricted area and manages security by generating an alarm or by setting a flag in the recording means when the article is in the restricted area (Column 2, lines 31-44 and Column 7, lines 10-41).

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shore (6,225,906).

25. Shore discloses the tag is attached to the user however fails to disclose the tag comprises a detachable sticker which the examiner considers to be for the use of attachment.

26. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the tag include a detachable sticker, because Applicant has not disclosed how providing a detachable sticker provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either no matter what attachment mechanism is used because both attachment mechanisms perform the same function of attaching a tag to a user.

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27. Therefore, it would have been an obvious matter of design choice to modify Shore to obtain the invention as specified in Claim 3.

Conclusion

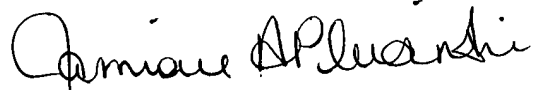
28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dione (US 2004/015334) discloses the use of an occupant monitoring method for a building, Verdiramo (US 2005/0288937) discloses the use of a system and method for tacking individuals in a facility, and Dabbieri (6,226,622) discloses a method for tracking individuals using GPS.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Jamisue Plucinski". The signature is fluid and cursive, with the first name "Jamisue" and last name "Plucinski" clearly distinguishable.

Jamisue Plucinski
Patent Examiner
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